

REMARKS

Restriction Requirement

Applicants hereby confirm that during a 10/14/04 telephone conference with the Examiner, claims 4-6 were withdrawn, without prejudice, as relating to a non-elected invention. Claims 1-3 remain pending.

Claim Objections

Claim 1 was objected to because the Examiner believed the term “like” in line 5 should be changed to –the--. Applicants agree and claim 1 has been amended accordingly.

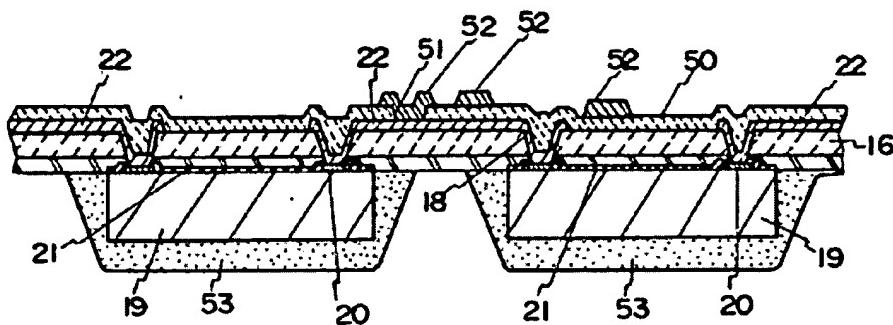
Claim Rejections

Pending claims 1-3 were rejected as obvious in view of the combination of U.S. Patent Nos. 4,246,595 to Noyori (“Noyori”) and 5,879,503 to Gustafson (“Gustafson”). This rejection should be withdrawn for at least the following reasons.

First, the Examiner’s reading of the Noyori patent appears to be at odds with what is actually disclosed therein, which means that even if Noyori could be combined with Gustafson in the manner suggested by the Examiner, the combination still would be missing limitations of the rejected claims. For example, according to the Examiner, Noyori discloses “a flat collective plate substrate (16, Fig. 9) comprising . . . a first surface (50) . . . and a second surface (52) opposite the first surface.” *See* Office Action at p. 3, para. 7. In Fig. 9 of Noyori, however, neither of surfaces (50) or (52) are surfaces for substrate (16). Furthermore, looking at Fig. 9 there appears to be no basis for the Examiner’s characterization of surface (52) as “opposite the first surface” (50). *See* Office Action at p. 3, para. 7. The disclosure of the Noyori patent also does not seem to support that Examiner’s assertion that substrate (16) has a “second plurality of chips glued on a first surface” and “at least one SME component and/or a connector element” mounted on a second surface, as recited in limitations (b) and (g) of rejected claim 1,

respectively. See Office Action at pp. 3-4, para. 7. Finally, there appears to be no basis for the Examiner's assertion that the semiconductor device (19) disclosed in Fig. 9 of Noyori acts as BOTH an "active SMC component" and "at least one chip" within the meaning of the rejected claims. Fig. 9 of Noyori is shown below:

FIG.9



Second, even if the Examiner's reading of the Noyori disclosure was correct, the Examiner has not made the required specific showing that one of ordinary skill in the art would have been motivated to combine Noyori and Gustafson in the manner suggested. For example, there appears to be no support for the Examiner's assertion that:

[i]t would have been an obvious to one of ordinary skill in the art at this time the invention was made to have modified Noyori et al method by including the manufacturing process of Gustafson, to positively improve the tightness [sic.] of the body and increase its rigidity.

See Office Action at p. 4, para. 7. The § 103 rejection of claims 1-3 therefore is improper. See *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998) ("even where the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of

ordinary skill would have been motivated to select the references and to combine them to render the claimed invention obvious.”).

CONCLUSION

Applicants believe that all of the claims pending in the application now are in condition for allowance. Reconsideration of this application in view of the foregoing amendments and remarks respectfully is requested.

The Examiner is invited to call Applicants' undersigned attorney if doing so would expedite prosecution.

Respectfully submitted,



Rodger A. Sadler, Esq.
Registration No. 51,315
Attorney for Applicants
Orrick, Herrington & Sutcliffe LLP
666 Fifth Avenue
New York, New York 10103
Phone No.: (212) 506-5053
Fax No.: (212) 506-5151

Date: December 16, 2004